



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,914	01/05/2004	Kazunori Chiba	247303US3CONT	1981

22850 7590 04/25/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

HITESHEW, FELISA CARLA

ART UNIT	PAPER NUMBER
----------	--------------

1722

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,914

Applicant(s)

CHIBA ET AL.

Examiner

Felisa C. Hiteshew

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>see attached paper</u> . | 6) <input type="checkbox"/> Other: ____ |

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The PTOL 1449 has been received, reviewed and considered.

Applicant is invited to submit and discuss prior art in accordance with 37 C.F.R. 1.56, 1.97-1.99. The examiner is requesting copies of the prior art as cited in the specification. The prior art requested is listed as follows:

- 1) SU 1535565 A 01/15/1991 - Soviet Union
- 2) 64-70102 03/15/1989 - Japan
- 3) 2000-93701 04/04/2000 - Japan
- 4) 1465067 03/15/1989 - Japan

Applicant(s) arguments show that obvious translations have been made to the relied upon prior art(s) of record. Since the instant invention is so in depth, it is requested that the applicant(s) make any English translations available.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 1722

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-16166 A (Konica Corp.) and JP.9-38401 A (Organo Corp).

JP 2-16166 A (Konica Corp.) and JP.9-38401 A (Organo Corp). both teach a solid matter sublimation and refinement device having a separation roller with heating means and an agitating blade. The rotatable roller is partially submerged in the fluid to be evaporated as fluid evaporation mea

The difference being that JP 2-16166 A (Konica Corp.) and JP.9-38401 A (Organo Corp). do not teach the distance between the roller for evaporation and the roller for precipitation is adjustable. However, in the absence of unobvious results, it would have been obvious to one of ordinary skill in the art to use such publicly known rotatable rollers as the evaporation means in the sublimation and refinement device, as stated supra.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-16166 A (Konica Corp.) and JP.9-38401 A (Organo Corp). as applied to claims 1-6 above, and further in view of Fodor, et al (U.S. 2,608,472).

(Flosdorf, et al) U.S. 2,608,472 teaches an improved apparatus and process for the purification of salicylic acid by vacuum sublimation, which operates on short cycles, yet produces high yields without the necessity of recycling. Moreover, the apparatus and process may be advantageously and conveniently adapted to continuous or semi-continuous operation without sacrificing operating efficiency or high standard of product purity (see column 1, lines 33-42 and column 3, line 51 through column 4, line 69), respectively.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. In re Opprect 12 USPQ 2d 1235, 1236 (CAFC 1989); In re Bode 193 USPQ 12; In re Lamberti 192 USPQ 278; In re Bozek 163 USPQ 545, 549 (CCPA 1969); In re Van Mater 144 USPQ 421; In re Jacoby 135 USPQ 317; In re LeGrice 133 USPQ 365; In re Preda 159 USPQ 342 (CCPA 1968).

Expected beneficial results are evidence of obviousness, just as unexpected beneficial results are evidence of unobviousness. In re Novak 16 USPQ 2d 2041 (Fed. Cir., BPAI 1989); In re Hoffman 194 USPQ 126 (CCPA 1977); In re Skoll 187 USPQ 481 (CCPA 1975); In re Skoner 186 USPQ 80 (CCPA 1975); In re Garshon 152 USPQ 602 (CCPA 1967).


It is well within the expected skill of the technician to operate a process continuously. In re Dilnot 796 OG 591, 1963 CD 745 (p752).

It is sufficient that the reference(s) clearly suggest doing what the applicant(s) have done. In re Gershon 152 USPQ 602.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felisa Hiteshew whose telephone number is (571) 272-1463. The examiner can normally be reached on Mondays through Thursdays from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached on (571) 272-1137. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-1463.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866- 217-9197 (toll-free).


FELISA HITESHEW
PRIMARY EXAMINER
1722